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MICHAEL O. SCHEINBERG
P.O. BOX 164140
AUSTIN TX 78716-4140

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OFFICE OF PETITIONS

In re Application of :
Heribert Vogel :
Application No. 10/656,080 : ON PETITION
Filed: 5 September, 2003 :
Atty Docket No. HSS30 :

This is a decision on the petition filed on 19 September, 2006, requesting under 37 CFR 1.183 that the requirements of 37 CFR 1.55(a) (2) be waived such that applicant's claim for foreign priority benefit under 35 USC 119 of DE 10110659.9 be accepted by way of the submission of a copy certified by the World Intellectual Property Office (WIPO).

The petition is dismissed.

Petitioner asserts, on petition, that he cannot perfect his claim to foreign priority under 35 USC 119 and 37 CFR 1.55(a) which requires him to submit to the USPTO a certified copy of the aforementioned corresponding German application, as the original document has been destroyed. Petitioner asserts that the German application served as a priority document for international application PCT/EP02/02154. Petitioner submits a copy of the German application which asserts petitioner, has been certified by WIPO as a true copy.

Petitioners contend that this document should be accepted as certified in that (1) the German Patent Office originally provided a certified copy of the original DE 10110659.9 document that was included in the file of the corresponding international application, and (2) the WIPO has itself prepared a photocopy of the aforementioned copy of the German Patent Office certified copy of DE10110659.9 in the file of the international application, and that WIPO has certified that this copy is a true and exact copy of the German Patent office's certified copy of the original German priority document in question. Petitioner asserts that this is an extraordinary circumstance such that justice requires waiving the requirement for a copy certified by the German Patent Office because the certified copy is

unavailable and there is no alternative avenue available to applicant to perfect the priority claim.

However, 37 CFR 1.183, by its terms cannot be employed contrary to any provision of the patent statute. Here, the controlling provision of the applicable statute requires that the certified copy of the *original* DE 10110659.9 has both been provided and certified by the German Patent Office.

While, as petitioner correctly points out, 35 U.S.C. §119 does not require the filing of a certified copy of the corresponding foreign document, the specific language of the applicable statute still precludes relief in this matter. See 35 U.S.C. § 119(1994):

No application for patent shall be entitled to this right of priority unless a claim therefor and a **certified copy of the original foreign application**, specification, and drawings upon which it is based are filed in the Patent and Trademark Office before the patent is granted,
...Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers (emphasis added).

Here, the proffered copy of DE 10110659.9 is (1) a WIPO-prepared [photo]copy of a copy of the original foreign application, not a copy of the *original foreign application* as required by the statute, and (2) in any event, that [photo]copy has only been certified by the WIPO to be a true copy of a copy of the original foreign application, whereas the statute requires that the priority document must be certified by the German Patent Office-the foreign country in which the original foreign application was filed--to be a copy of the *original foreign application*. In other words, no relief can be granted as the statute requires that German Patent Office-not the WIPO-have certified the copy of the *original foreign application* actually submitted to the USPTO.

Here, the destruction of the original German application file by the German Patent Office such that a certified copy concededly cannot be provided to the USPTO defeats the underlying purpose of § 119(b)(1994), and USPTO acceptance of the priority claim in the absence of the certified copy of the original German application, specification, and drawings would improperly evade the stringent requirements of the statute. Since this is a requirement of the applicable law, the USPTO simply lacks the authority or discretion to relax any requirement of law. See Baxter Int'l,

Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998) (the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120); A. F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977), (since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute). Thus, in the absence of the German Patent office-certified copy of the original the application, specification, and drawings of the corresponding German priority document required by § 119(b)(1994), the USPTO simply cannot acknowledge applicant's claim for foreign priority, or excuse the lack of a German Patent office certified copy of that original document containing the application, specification, and drawings.

The additional \$270 owed for a petition under 37 CFR 1.183 (for a total of \$400) has been charged to counsel's deposit account. The fee was changed effective November 22, 2004. See 69 Fed. Reg. 56842 (Sept. 21, 2004).

Petitioner may wish to consider obtaining certification from the German Patent office of the WIPO copy of DE 10110659.9, and submitting that certified document in this subject application.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.


Douglas I. Wood
Senior Petitions Attorney
Office of Petitions